

## REMARKS

### Claim Objections

- 5 All of the original claims have been canceled and it is believed that none of the claims added herein include any informalities previously noted by the Examiner.

### Claim Rejections -35 USC §112

- 10 All of the original claims have been canceled and it is believed that none of the claims added herein include any informalities previously noted by the Examiner.

### Claim Rejections -35 USC §102 and §103

- 15 Insofar as the rejection original claims under 35 U.S.C. 102 and 103 as being unpatentable over Thrasher US patent application number 2004/0176142 might be applied to claims new claims 60-74, consideration of the following is requested.
- 20 All of the original claims have been cancelled and new claims added (both apparatus and method) herein include express reference to an input in the bracelet that produces a response in a security panel. New claims 73-74 include a further limitation to comparing a caller ID with an internal database to match it with a name as recited in the specification at page 5 lines 28-29. Other claims
- 25 added herein are expressly limited to specific responses in the security panel in response to an input at the bracelet. These include
1. causing the associated phone line to go off hook.
- 30 2. causing the phone line to go off hook and a predetermined message to be delivered to an individual placing an incoming call.

3. activation of an audio amplifier.

4. Initiating a message to an incoming caller that the user will answer the call  
5 shortly.

The 35 USC §102 rejection included:

10 "Regarding Claims 11, 16, 31, and 36 it is inherent that the bracelet would  
include pushbuttons to produce a predetermined output."

Applicant respectfully asserts that pushbuttons to produce a predetermined  
output features recited in the claims added herein are not described, either  
expressly or inherently in the Thrasher, as required by 35 U.S.C. §102 and  
15 relevant case law as summarized in the MPEP 2131. Further, it is well settled  
that "When the PTO asserts that there is an explicit or implicit teaching or  
suggestion in the prior art, it must indicate where such a teaching or suggestion  
appears in the reference." In re Yates, 211 USPQ 1149, 1151 (CCPA 1981). The  
Examiner has failed to identify the pushbuttons to produce a predetermined  
20 output features recited in the now pending claims.

The 35 USC §103 rejection included:

25 "Thrasher and Dowling are combinable because they are from the same  
field of endeavor, that is, remote caller identification alerting. At the time of  
the invention, it would have been obvious to one of ordinary skill in the art  
to modify Thrasher to include Dowling. The motivation for this modification  
would have been to provide additional means to get the user's attention to  
30 notify them of an incoming call."

Applicant does not in any way concede that the combination of references would teach the present invention. Moreover, it is respectfully submitted that the combination of references is not permissible because it fails to meet the established standard:

5 In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998) ("When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, 10 or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.");

Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1385 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the 15 prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.");

20 In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (there must be "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references");

25 Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.");

Applicant expressly asserts that the statement "The motivation for this modification would have been to provide additional means to get the user's 30 attention to notify them of an incoming call." is mere impermissible hindsight using the disclosure of the present application.

Furthermore, it is submitted that even if the combination of Thrasher and Dowling were permissible it would not lead to the invention as presently claimed. 35 Thrasher is believed to be merely a display device to inform a remote user.

Dowling, at most discloses, in paragraph 0016 "... limited functions can be performed through the small remote device. Limited functions can include answering, call by voice command and menu response functions." The meaning of these terms is not clear. Applicant reiterates that there is no suggestion to  
5 combine the two references and that even if they were combined the specific aspects of the applicants presently claimed invention are not shown are suggested alone or in combination by the cited references.

10 It is respectfully submitted that the claims submitted herewith are allowable and such action is requested.

Should a petition for an Extension of Time be necessary for the timely reply to the outstanding office action (or such a petition has been made and an additional extension is necessary) petition is hereby made in the Commissioner is  
15 authorized to charge any fees (including additional claim fees) to Deposit Account Number 19-2635 under Attorney Docket Number H0005941-0555.

Respectfully submitted,



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